

REMARKS

On April 12, 2002, Applicants submitted a Preliminary Amendment which included, *inter alia*, a claim for priority to U.S. Patent No. 09/663,255, which claims priority to Provisional Application No. 60/168,057, filed November 30, 1999 and a petition to add Mr. Younger Ahluwalia as an inventor of the instant application. The petition was granted on November 14, 2002.

The Preliminary Amendment also includes a declaration by Younger Ahluwalia attesting that he is the inventor of the subject matter of U.S. Patent No. 5,965,257 and that the instant application and U.S. Patent No. 5,965,257 are currently owned by the same party.

The Preliminary Amendment, as evidence by a stamped return receipt postcard, was received by the U.S. Patent and Trademark Office on April 15, 2002.

An Office Action was mailed on April 25, 2002. Therefore, the Preliminary Amendment was mailed to and received by the U.S. Patent and Trademark Office before the April 25, 2002 Office Action was mailed. However, the Preliminary Amendment was not considered in the Office Action.

In May 2002, counsel for the Applicants telephoned the Examiner and requested that a new Office Action be issued based upon the consideration of the Preliminary Amendment. The Examiner notified counsel that due to the routing of the file within the PTO, that the Examiner did not have the file and would not be able to issue a new Office Action before the deadline for filing a response.

To avoid payment of extension of time fees, Applicants submitted a Response on July 25, 2002, formally requesting that the Preliminary Amendment be entered and that a new Office Action be issued.

On October 23, 2002, the PTO issued a second non-final office action. However, this Office Action again fails to take into account the Applicants' argument in the preliminary amendment filed on April 12, 2002, that the Ahluwalia reference does not qualify as prior art.

Rather, the Office Action rejects claims 1-27 under 35 U.S.C. § 103 as being unpatentable over Ahluwalia in view of Meyer and rejects claims 1, 2, 10-12, and 14-27 under 35 U.S.C. § 103(a) as being unpatenable over Ahluwalia in view of Davies.

Applicants respectfully traverse and submit that, as stated in the preliminary amendment, the Ahluwalia reference cannot render the claimed invention obvious as the reference does not qualify as prior art. The Ahluwalia reference issued as a patent in October 1999, less than one year before the November 30, 1999 filing date of U.S. Provisional Application No. 60/168,057, to which the present application claims priority. Thus, the Ahluwalia reference is not statutory prior art.

The amendment of the claim for priority, the amendment of inventorship to add Mr. Ahluwalia, and the declaration by Mr. Ahluwalia stating that he is the inventor of the material disclosed in the Ahluwalia reference and that the Ahluwalia reference is currently owned by the same party disqualifies Ahluwalia reference as prior art. M.P.E.P. § 718. A terminal disclaimer is also enclosed.

Applicants respectfully request reconsideration of the claims in view of the preliminary amendment and grant of the petition to amend inventorship and earnestly solicit

prompt allowance of the claims. If the claims are not allowable, Applicants respectfully request that the next Office Action should not be a Final Office Action.

Double Patenting Rejections

Claims 1-13 and 15-27 have been rejected as being unpatentable over claims 1-19 of U.S. Patent No. 5,965,257 in view of Meyer and claims 1, 2, 10-12 and 14-27 have been rejected as being unpatentable over claims 1-19 of U.S. Patent No. 5,965,257 in view of Davies under the judicially created doctrine of obviousness-type double patenting. Applicant respectfully traverses. However, the filing terminal disclaimer overcomes this rejection. As such, withdrawal of the rejection is requested.

Claims 1, 10, 11 and 14¹ have been rejected for double patenting in view of claims 1-3 of U.S. Patent No. 6,500,560 ("Kiik") in view of Meyer and claims 1, 2, 10, 11 and 14 are rejected for double patenting in view of claims 1-3 of U.S. Patent No. 6,500,560 in view of Davies.

In particular, the Examiner alleges that it would have been obvious to coat the roofing underlayment of Kiik with either the heat reflective elastomeric coating composition disclosed by Meyers or with the heat reflective aluminum containing coating of Davies.

Applicants respectfully traverse. Independent claim 1 of U.S. Patent No. 6,500,560 (the only claim which mentions a roofing underlayment) is directed toward a roofing assembly comprising a roofing underlayment in combination with concrete tiles. None of the cited references contain any teaching to coat an underlayment, that is underneath concrete tiles,

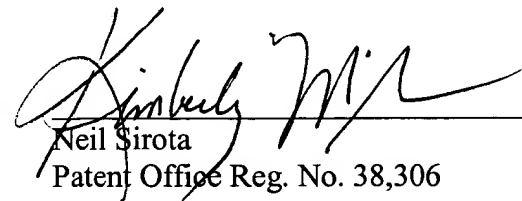
¹ The Office Action states that claims 1, 10, 11, and 14 are rejected under Kiik in view of Meyer (OA, p. 10). However, the body of the rejection discusses claims 2, 3, and 13 (OA, p. 11), which are not rejected. Applicant requests that the Examiner clarify what claims are rejected and what claims are not rejected and the basis for the rejection.

with a heat reflective element. As such, the instant invention is not obvious over the claims of U.S. Patent No. 6,500,560 and withdrawal of the double patenting rejection is requested.

Applicants do not believe that any fee is required in connection with the submission of this document. However, should any fee be required, or if any overpayment has been made, the Commissioner is hereby authorized to charge any fees, or credit or any overpayments made, to Deposit Account 02-4377. Duplicate copies of this sheet are enclosed.

BAKER BOTTS L.L.P.

By:


Neil Sirota
Patent Office Reg. No. 38,306

Kimberly J. McGraw
Patent Office Reg. No. 50,994
(212) 408-2502 (direct dial)

30 Rockefeller Plaza
44th Floor
New York, NY 10112-4498

Attorneys for Applicants
(212) 408-2500